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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,600	05/23/2001	Virginia Smith-Swintosky	PRI-0014 (ORT-1436)	9298

7590 04/02/2003

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EXAMINER

MOHAMED, ABDEL A

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 04/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/863,600

Applicant(s)

SMITH-SWINTOSKY ET AL.

Examiner

Abdel A. Mohamed

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status***For Restriction Purpose only*

- 1) ☒ ~~Responsive to communication(s) filed on \_\_\_\_\_.~~
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-37 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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### **ELECTION/RESTRICTION**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-22, drawn to a method for treating a patient having a condition mediated by neurotoxicity, neurodegeneration or neurological damage comprising administering SEQ ID NOS:1-48, respectively, classified in class 514, subclasses 13, 14, 15 and 16.
- II. Claims 23-32, drawn to a method of activating a cell surface receptor to induce neuroprotective biological activity comprising contacting SEQ ID NOS:1-48, respectively, classified in class 530, subclasses 326,327, 328 and 329.
- III. Claims 33-37, drawn to a method of preparing a cell surface receptor agonist comprising dimerizing a cell surface antagonist, classified in class 530, subclass 333.

The sequence limitations of claim 1, for example, show that conserved or nonconserved amino acid can be substituted for any of Xs. Therefore, that sequence described as SEQ ID NO:47 encompass peptides have different structure. These peptides are therefore patentably distinct one from the other. For example, a) Independent of whether Group I or II or III is elected, the peptides recited in the claims are considered as patentably distinct and/or independent, one from the other; and are capable of independent use.

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b) Applicant's response should indicate the specific Group, I or II or III that is elected.

c) Applicant's response should indicate one specific peptide by SEQ ID NO:.

d) Where the elected peptide defined by SEQ ID NO: contain "X" (Xaa) in the sequence,

Applicant also needs to uniquely identify a specific amino acid residue (e.g., Alanine at position

3) for each Xaa in the sequence.

Applicant is to elect a single disclosed sequence, and/or provide a single subsequence within a disclosed sequence wherein the subsequence for the elected is searched.

The methods of Group I, Group II, Group III are unrelated in that they require SEQ ID NOS:1-48. They are patentably distinct because the methods vary in steps and outcomes. The groups require different patent classes and subclasses and literature search and a reference teaching a method for treating a patient having a condition mediated by neurotoxicity, neurodegeneration or neurological damage will not teach a method of activating a cell surface receptor to induce neuroprotective biological activity nor a method of preparing a cell surface receptor agonist and *vice versa*. Thus, the methods of Groups I-III are independent and distinct inventions which differ in material make up and composition requiring different reaction conditions. Hence, one does not require the other for ultimate use and as such is capable of separate manufacture, use and sale, and is novel and patentable over each other.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because the searches for individual subject sets are not coextensive, restriction for examination purposes as indicated is proper.

A telephone call was made to Janet E. Reed on 3/26/03 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

#### **CONCLUSION AND FUTURE CORRESPONDENCE**

Claims 1-37 are subject to restriction or election requirement.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdel A. Mohamed whose telephone number is (703) 308-3966. The examiner can normally be reached on Monday through Friday from 7:30 a.m. to 5:00 p.m. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached on (703) 308-2923. The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
CHRISTOPHER S. F. LOW  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

 Mohamed/AAM

March 27, 2003